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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,162	08/28/2004	Vladimir Khripach		5161

7590 11/15/2007

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EXAMINER
GUPTA, ANISH

ART UNIT	PAPER NUMBER
1654	

MAIL DATE	DELIVERY MODE
11/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/711,162	Applicant(s) KHRIPACH ET AL.	
	Examiner Anish Gupta	Art Unit 1654	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: 11-13.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

10/22/07
ANISH GUPTA
PRIMARY EXAMINER

Continuation of 5. Applicant's reply has overcome the following rejection(s): Claim 11-13 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention..

immunoconjgated mentioning and claimed in the Patent Application, but only discussing is 24-epibrassinolide, a plant hormone whose HIV-inhibiting activity has never been known before." The claims are not drawn to a treatment. "It is an in vitro HIV-inhibiting effect of 24-epibrassinolide, which as been discovered and documented by the authors." The specification provides one of ordinary skill in the art to make and use the claimed invention and thus the claims are enabled in this context.

Applicants arguments have been fully considered but have not been found persuasive.

Under 35 USC 112 First paragraph, the claims must be enabled for a real world " value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research. See MPEP 2106. Applicant seem to be implying that they have only discovered an in vitro HIV-inhibiting use. Accordingly this would violate the requirements under 35 USC 101 since the in-vitro method might not have a "real world" use and is simply a starting point for future investigation or research. Thus clarification is requested.

In any event, the claims are drawn to a pharmaceutical composition. Pharmaceutical compositions imply in-vivo use as medications. This conclusion is reflective in the teachings on page 5 of the specification where it states "in a first aspect, the invention relates to the use of epibrassinolide for the preparation of medicine for the treatment of HIV." Thus, since the only real world use recited in the specification for the pharmaceutical is treatment of HIV, claims have been interpreted as such. While the claims may not specifically claim as much, one reading the specification would get the sense that the pharmaceutical composition is useful in the treatment of HIV. For the reasons set forth in the previous office action, the claimed invention is not enabled on how to use the pharmaceutical formulation for in-vivo use.

For the art rejection, Applicants seem to argue that Kajita et al. is similar to hundreds of other references that are only concerned with stimulation effect and none relates to protective effects for an animal cells infected by a dangerous virus. "Thus, our Patent Application is intended to claim a new unique property of known natural compound that has been discovered by the authors."

Applicants arguments have been fully considered but have not been found persuasive.
It has been held that the granting of the patent drawn to a composition cannot be based on a new use for the composition. See In Re Hack, 114 USPQ 161, 163 (CCPA 1957). The recitation of a new intended use for an old product does not make a claim to that old product patentable. In re Spada, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) ("The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from prior art, can not impart patentability to claims to the known composition."); In re Pearson, 181USPQ 641, 644 (CCPA 1974) (intended use of an old composition does not render composition claim patentable); In re Benner, 82 USPQ 49, 53 (CCPA 1949) ("no provision has been made in the patent statutes for granting a patent upon an old product based solely upon discovery of a new use for such product"). In In re Zierden, 162 USPQ 102, 104 (CCPA 1969), one of the claim at issue was drawn to a "composition for removing and preventing alluvium deposits in water systems consisting essentially of insoluble potassium metaphosphate, solublizing agent therefor and a compatible dispersing agent." Zierden, at 103. Appellants argued that the prior art at issue did not disclose or suggest that the composition of the prior art could be utilized to prevent alluvium deposition, as well as calcium carbonate deposition, from industrial waters. Zierden at 103. The U.S. Court of Customs and Patent Appeals maintained the prior art rejection under 102 and stated that "A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable" Zierden at 104. The Court further stated, citing In re Lemin, 104 USPQ 273 (964), that the "difference over the prior at must be more substantial than a statement of intended use" and the composition of the prior art would be exactly the same whether the user were told to use it for the claimed purpose or the purpose disclosed in the prior art. Zierden at 104.
Rejection is maintained.